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REMARKS

Applicants thank the Examiner for the thorough consideration given the present application.

Claims 6, 8-10, 13, 17-20, 23-28, and 31-41 were previously cancelled. Thus, claims 1-5, 7, 11, 12, 14-16, 21, 22, 29, 30, and 42-45 are pending, of which claims 1 and 21 are independent; claims 1, 5, 7, 12, and 14 are amended; and claims 42-45 are added to provide Applicants with the protection to which they are deemed entitled. Support for added claims 41-45 can be found in the specification as filed, e.g., at page 16, lines 21-23.

Applicants traverse the rejections under 35 U.S.C. §103(a) of claims 1, 2, 4, 5, 7, 11, 12, 14-16, 21, 22, 29, and 30 as being unpatentable over Treyz (U.S. 6,587,835 B1) in view of Esposito (U.S. 6,587,838 B1) and of claim 3 based on Treyz and Esposito in view of Semple (U.S. 6,408,307).

While not acquiescing to any rejection, but merely to expedite prosecution, independent claim 1 is amended to recite a shopping assistance service method having a combination of steps, including delivering to a user at least one of comparative-pricing data and availability data for an identified item type for business premises relative to a location, the data being categorized into zones of different physical accessibility of the

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business premises concerned from the location, the delivering step being over a communication link originating at the service system and including a mobile radio infrastructure.

Independent claim 21 is directed to a shopping-assistance service system having a combination of elements, including a task subsystem for obtaining, for a type of item identified by the processing subsystem, at least one of comparative-pricing and availability data with respect to other business premises, the task subsystem being arranged to categorize the data according to zones of different physical accessibility of the business premises concerned from said location.

None of the references of record, including Treyz, Esposito, and Semple, discloses or suggests a shopping-assistance service method or system having the above-noted combinations of steps and elements.

In rejecting claims 1 and 21, the Examiner persists in putting forth an inherency argument unsupported by Treyz. As discussed in the Amendment filed October 4, 2004, the fact that a certain result or characteristic *may* occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In the present case, there has been no showing of inherency sufficient to establish that the missing

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descriptive matter is present in the reference and that it would be so recognized by persons of ordinary skill in the art.

In the previously filed response, Applicants requested the Examiner to specifically indicate the basis for asserting that Treyz discloses data being categorized into zones of different physical accessibility of the business premises concerned from the location. The Examiner has not done so. In fact, none of the portions of Treyz identified in the Office Action (i.e., column 21, lines 25-35; column 24, lines 13-15; and FIGS. 26-28, 42, 45, 72, and 96) describes data being categorized into zones of different physical accessibility as required by Applicants' independent claims 1 and 21. Nor is this issue addressed in the "Response to Arguments," which only confirms consideration of Applicants' previous arguments with respect to cancelled claim 6. Accordingly, the allegation of inherency is unsupported and must fail.

Similarly, the Office Action fails to identify a teaching, suggestion, or motivation for combining Treyz and Esposito as proposed. The Office Action appears to contain numerous unsupported allegations regarding the purported success of combining Treyz and Esposito without identifying the source of motivation for one of ordinary skill in the art to combine the

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references. The Office Action discusses customer satisfaction and the probability of a customer's continuing to use a system increasing sales and profits for commercial entities; however, nowhere does the Office Action identify any motivation or suggestion in either reference teaching, suggesting, or describing the asserted combination.

The fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness. A statement that combinations of the prior art to meet the claimed invention would have been well within the ordinary skill of the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. See MPEP 2143.01 quoting *Ex parte Levengood*, 28 USPQ2d 1300 (BPAI 1993). According to *Levengood*, obviousness cannot be established by combining references "without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done." The present Office Action merely states that the references can be combined, which Applicants contend to the contrary, and does not state any desirability found in the references for combining the references.

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In other words, the Office Action fails to supply any objective reasons to combine the applied references.

In accordance with MPEP §2143.01 and *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999), the Examiner is again requested to identify a teaching, suggestion, or motivation in either reference or to provide an affidavit of facts within the personal knowledge of the Examiner per MPEP §2144.03 providing a motivation or suggestion to one of ordinary skill in the art to make the argued combination.

"When an obviousness determination is based on multiple prior art references, there must be a showing of some 'teaching, suggestion, or reason' to combine the references." *Winner International Royalty Corp. v. Wang*, 53 USPQ2d 1580, 1586 (Fed. Cir. 2000). The Examiner has failed to make such a showing supporting the applied combination of references and therefore the applied combination of references is improper. The Examiner is in error for any of the above reasons and has not made out a *prima facie* case of obviousness, and the rejection of claims 1 and 21 should be withdrawn.

Regarding claim 2, the Examiner asserts that Esposito "teaches a method, wherein said location is that of the business premises where the item is being offered."

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Contrary to the Examiner's assertion, Esposito fails to teach that the location is the business premises where the item is being offered. Column 5, lines 1-6, of Esposito appears to describe a determination of location information of the user in order to determine wireless service provider region and terminal accounts for receiving vendor notifications. For at least this reason and the reasons advanced above with respect to claim 1, claim 2 is patentable, and the rejection should be withdrawn.

Regarding claim 4 of Treyz, the Examiner admits that Treyz fails to disclose a user profile held by the service system and the Examiner has failed to identify any teaching in any reference curing the admitted deficiency of Treyz. The Examiner makes unsupported assertions regarding motivation of a person of ordinary skill in the art to extend Treyz to include a user profile and, as stated above, the Examiner fails to provide a reference providing any motivation to modify Treyz. Additionally, the asserted motivation of ensuring the party is in the correct location is unclear to applicant. For at least this reason and for the reasons advanced above with respect to claim 1, claim 4 is patentable and the rejection should be withdrawn.

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Regarding claim 5 of Treyz, none of the cited figures describe determining data for items categorized into respective sets of zones of different physical accessibility as claimed in claim 5. The Examiner is requested to identify with particularity where in each of the cited figures the Examiner believes the limitation is described. For at least this reason and for the reasons advanced above with respect to claim 1, claim 5 is patentable and the rejection should be withdrawn.

Regarding claim 7 and related claims 22 and 30 of Treyz, similar to claim 5 above, Treyz fails to disclose zones comprising a convenient walking zone around a location and a convenient driving zone around a location. FIG. 28 of Treyz depicts a price comparison screen with no zone information or location information, FIG. 42 depicts a map of a location including directions, and FIG. 45 depicts another map of a location. None of the cited figures describe or depict the zones as claimed in claim 7. The Examiner is requested to identify with particularity where in each of the cited figures the Examiner believes the limitation is shown. For at least this reason and for the reasons advanced above with respect to claim 1, claims 7, 22, and 30 are patentable, and the rejection should be withdrawn.

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Regarding claim 11, claim 11 depends from claim 1, includes further important limitations, and is patentable over the applied references for at least the reasons advanced above with respect to claim 1. For at least this reason, the rejection of claim 11 should be withdrawn.

Regarding claim 12, Trezz fails to describe a specific task as including one of delivering comparative-pricing data and delivering availability data being selected by the party responsible for sending the information. For at least this reason and for the reasons advanced above with respect to claim 1 from which claim 12 depends, the rejection of claim 12 should be withdrawn.

Claims 14 and 15 depend from claim 1, include further important limitations, and are patentable over the applied references for at least the reasons advanced above with respect to claim 1. For at least this reason, the rejection of claims 14 and 15 should be withdrawn.

The Examiner's statement regarding claim 16 is not understood as claim 16 recites the item of interest is a service, while claim 15 recites that the item of interest is a product. Further clarification from the Examiner is hereby requested. Claim 16 depends from claim 1, includes further import limitations, and is

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patentable over the applied preferences for at least the reasons advanced above with respect to claim 1. For at least this reason, the rejection of claim 16 should be withdrawn.

Regarding claim 27, claim 27 has been previously canceled.

Regarding claim 29, claim 29 depends from claim 21, includes further important limitations, and is patentable over the applied references for least reasons advanced above with respect to claim 21. Further and similar to claims 1, 5, and 21 described above, the Examiner again identifies a list of figures in Treyz and asserts that they disclose the claimed subject matter without identifying with any particularity where in the figures respective sets of zones of different physical accessibility are described. The Examiner is incorrect and is requested to identify with particularity where the cited figures disclose the claimed subject matter. The rejection of claim 29 should be withdrawn.


Regarding claim 3, the arguments advanced above with respect to claim 1, from which claim 3 depends, apply equally to claim 3 and for at least this reason the rejection of claim 3 should be withdrawn. Further, Semple does not disclose the above-noted features of independent claim 1, nor does Semple cure the deficiencies of Treyz and Esposito.

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In view of the foregoing amendments and remarks, it is respectfully submitted that independent claims 1 and 21 are allowable. The remaining claims are also allowable due to dependence, directly or by extension, on allowable independent claims 1 and 21, as well as for the additional limitations provided by these claims. Favorable reconsideration and allowance of the application are, therefore, deemed in order.

To the extent necessary during prosecution, Applicants hereby request any required extension of time not otherwise requested and hereby authorize the Commissioner to charge any required fees not otherwise provided for, including application processing, extension, and extra claims fees, to Deposit Account No. 08-2025.

Respectfully submitted,
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